

**REMARKS**

Claims 1-17 are pending in the application.

Claims 1 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 1 recites the limitation “the remote control signal form” in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation “the remote control signal form” in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-11 and 14-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vardi in view of Sato (U.S. Patent No. 5,949,407).

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Vardi in view of Sato as applied to claim 1 and further in view of Williams.

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Vardi in view of Sato as applied to claim 1 and further in view of Schiller, et al.

The Applicants traverse the rejections and request reconsideration.

***Prior Art Rejections***

**Rejection of claims 1-11 and 14-17 based on Vardi and Sato**

In rejecting the claims under section 103(a) based on Vardi and Sato, the Examiner admits that there is no mention of command codes being output in remote control signal form in Vardi. The Examiner cites Sato to overcome this deficiency.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142 *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As noted in the previous response, Verdi merely teaches predetermined operations being performed directly using the perceived hand motion. On the other hand, in the present invention as recited in Claims 1 and 14, a command code corresponding to perceived motion information (for example, the hand motion of Vardi) is transmitted to another device (that is, the controlled device). In the present invention, **a process for searching whether a command code corresponding to the perceived motion information is required. Specifically, the present invention requires searching whether the perceived motion information corresponds to preset motion information.**

Even with a broad interpretation of the teachings of Vardi and Sato, it merely uses command codes stored in memory to control multiple devices. However, combined teachings of Sato and Verdi do not teach or suggest **a process for searching whether a command code corresponding to the perceived motion information is required. Moreover, the combined teachings do not suggest searching whether the perceived motion information corresponds to preset motion information.**

From Vardi a skilled artisan can arrive at performing operations using perceived hand motion and Sato teaches command codes in general. As noted above there is still a significant gap in the combined teachings which will not be obvious for a skilled artisan to fill in.

Moreover, the present application uses information on motion of an apparatus body and a corresponding command code. Therefore, it includes a motion detection unit adapted to detect at least one motion of an apparatus body. However, Sato uses position designation information according to key operations and a corresponding command code, so it does not include any part corresponding to the motion detection unit of the present application. The data storage unit of the present application stores motion information and a corresponding command code, whereas the memory of Sato stores a command code corresponding to coordinate position. That is, the data storage unit of the present application is distinct from the memory of Sato.

Additionally, the present application is distinct from Vardi as argued previously in responding to the first Office Action. Therefore, the combined teachings of Vardi and Sato do not suggest all features of claim 1 of the present application cannot be taught.

The Applicants respectfully submit that the patent office has not satisfied the burden of establishing *prima facie* obviousness at least because it has not satisfied at least the “all limitations” and “motivation” prongs of the three prong test for obviousness. Specifically, the patent office has not shown that the combined teachings of Vardi and Sato suggest the present invention as a whole, including the requirement of a process for searching whether a command code corresponding to the perceived motion information is required and searching whether the perceived motion information corresponds to preset motion information.

The USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. See, *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), citing, e.g., *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). *In re Lee*, the Federal Circuit went on to emphasize that the “need for specificity pervades this authority.” *In re Lee* at 1433 (emphasis added) (citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”).

However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *Id.*, citing, *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Kotzab*, 99-1231 (CAFC June 2000, citing *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

The court in *Kotzab* further accentuates that close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood

may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id. quoting W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Federal Circuit appears to be clearly talking about the kind of situation as in the present case. The Applicants respectfully submit that the pending grounds of rejection do not satisfy the Federal Circuit's rigorous standard for demonstrating that the claimed invention would have been obvious in view of the cited references. The patent office has not established *prima facie* obviousness because he has not shown where in the combined teachings of the cited reference the above mentioned teaching is suggested. Since the "all limitations" prong of the three prong test fails, the "motivation" prong must also fail.

Claims 2-11 and 14-17 depend on claim 1 and are allowable at least for the same reasons.

Rejection of claim 12 under 35 U.S.C. 103(a) based on Vardi in view of Williams

Claim 12 is dependent on claim 1, and is allowable at least for the same reasons. Further Williams does not overcome the deficiencies noted above in relation to claim 1.

Specifically, Williams is related to a portable computer displaying information as a perceived motion. However, Williams does not include a structure corresponding to the transmission unit of the present invention, which transmits the command code corresponding to each motion to another controlled device.

Rejection of claim 13 under 35 U.S.C. 103(a) based on Vardi in view of Schiller et al.

Claim 13 is dependent on claim 1, and is allowable at least for the same reasons. Further Schiller does not overcome the deficiencies noted above in relation to claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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